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**MAR 1 1 2005**

In re Application of  
Horwitz, et al.  
Application No. 10/757,590  
Filed: January 15, 2004  
Attorney Docket No. 032425-001  
For: METHOD FOR PRODUCING NOVEL DNA  
SEQUENCES WITH BIOLOGICAL ACTIVITY

**OFFICE OF PETITIONS**

**ON  
PETITION**

This is a decision on the petition filed December 15, 2004, to accord the above-identified application a filing date of January 15, 2004 on two grounds. First, petitioners assert incorporation by reference as the means by which the drawings from application no. 09/132,231 should be considered part of the present application. This type of petition is treated under 37 CFR 1.53(e). Second, petitioners request that pursuant to 37 CFR 1.57(a), Figures 1-6 of the parent application be added to the present application because the present application contains a priority/benefit claim to the parent application.

The petition under 37 CFR 1.57(a) is **DISMISSED AS MOOT**.

The petition under 37 CFR 1.53(e) is **GRANTED**.

The petition under 37 CFR 1.57(a) is **dismissed as moot** because the provisions of 37 CFR 1.57(a) only apply to applications filed on or after September 21, 2004. This application was filed on January 15, 2004. No fee has been charged in connection with this petition.

On January 15, 2004, the application was deposited.

On October 18, 2004, the Office of Initial Patent Examination mailed a Notice stating that drawings were missing and that a filing date would be accorded upon receipt of the missing items.

In response, the present petition alleges that drawings were inadvertently omitted. However, the Application Transmittal letter incorporated by reference the entire disclosure of the parent application, no. 09/132,231.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted.

Based on the incorporation by reference, it appears that the drawings were present in the Office on January 15, 2004, albeit in the file of another application, i.e., application No. 09/132,231. Therefore, on petition, the application may be accorded the requested filing date of January 15, 2004.

In view of the above, the petition under 37 CFR 1.53(e) is **granted**. The copy of the drawings from application no. 09/132,231 submitted with the petition will be used for examination purposes.<sup>1</sup>

The petition fee of \$400 is required since the petition was required to accord the application the requested filing date. The fee will be charged to application no. 02-4800.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of January 15, 2004, using the application papers filed on January 15, 2004 and the copy of the drawings from application no. 09/132,231 filed on December 15, 2004.<sup>2</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



E. Shirene Willis  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> The Office assumes that the drawings are a true and exact copy of the drawings submitted in the parent application. If this is not the case, then petitioner must notify the Office. Of course, the primary examiner is expected to compare the instant drawings to the drawings in the parent application in order to verify that the drawings are, in fact, part of the prior application.

<sup>2</sup> The formal drawings from grandparent application no. 08/316,415 will not be processed.